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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/688,279

10/17/2003

Baihua Wu

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9189

7590

12/05/2005

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EXAMINER

DAVIS, BRIAN J

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/688,279

Applicant(s)

WU ET AL.

Examiner

Brian J. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-147 is/are pending in the application.
- 4a) Of the above claim(s) 30-97, 106-121 and 128-147 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 98-105 and 122-127 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/04;5/10/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restriction***

Applicant's election (10/24/05; 7/11/05), without traverse, of the claims of Group I and the species of claim 4 as the Group and species elected to begin prosecution is acknowledged and hereby made FINAL.

The claims of Group II (claims 30-57, 106-110, 128-133), Group III (claims 111-115, 134-140) and Group IV (claims 89-97, 116-121, 141-147) are hereby withdrawn as being drawn to non-elected subject matter.

### ***Information Disclosure Statement***

On the 2/9/04 IDS, two entries have been lined-through: on page 1 of the IDS, the "Search Results" entry because it is not a printed publication, but merely a printed segment of a database; and on page 19 of the IDS, the patent 326,456 pertains to a runner attachment for carriages – something clearly not germane to the instant invention.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29, 98-105 and 122-127 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

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subject matter which applicant regards as the invention. It is unclear exactly what applicant wishes to claim: a compound, or a composition which contains this compound. The first clauses of claim 1, for instance, are drawn clearly and explicitly to a compound, yet the terminal clauses of the claim directly contradict this by setting forth limitations applicable only to a composition. A similar analysis holds for the other independent claims.

The examiner notes for the record that for the purposes of this Office Action, the instant claims have been examined with the assumption that they are drawn to a purified compound, which is in keeping with applicant's teachings in the specification and appears to also be applicant's intent in the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The elected species has been searched (the first species searched in a compound-by-compound Markush search) and is not deemed free of the prior art.

Claims 1-29, 98-105 and 122-127, in so far as they read on the elected species, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by applicant's own admission.

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Applicant explicitly states on page 1 line 20 of the specification that O-(3-chloro-2-propenyl)hydroxylamine (the elected species of claim 4) and its salts are important intermediates for the synthesis of herbicides. That is, applicant admits that the species of claim 4 and its salts are old and well-known compounds in the art. The claims are then drawn to a purified form of this old and well-known compound.

However, there are a number of decisions holding that where the purification of an old product results in a mere change in degree in its properties, the purified form is unpatentable. *Ex parte Windhaus*, 15 USPQ 45 (POBA 1931); *In re Ridgeway*, 76 F.2d 602, 25 USPQ 202 (CCPA 1935); *In re Mertz*, 97 F.2d 599, 38 USPQ 143 (CCPA 1938); *In re Macallum*, 102 F.2d 614, 41 USPQ 146 (CCPA 1939); *In re King*, 107 F.2d 614, 43 USPQ 400 (CCPA 1939); *Ex parte Sparhawk*, 64 USPQ 339 (POBA 1945); *In re Weijlard*, 154 F.2d 133, 69 USPQ 86 (CCPA 1946); *In re Johnson*, 94 F.2d 978, 37 USPQ 75 (CCPA 1938); *Ex parte Cavillito*, 89 USPQ 449 (POBA 1950); *Ex parte Snell*, 86 USPQ 496 (POBA 1950); *In re Fisher*, 307 F.2d 948, 135 USPQ 22 (CCPA 1962); *Ex parte Hartop*, 139 USPQ 525 (POBA 1962); *Ex parte Siddiqui*, 156 USPQ 426 (POBA 1966); *Ex parte Schmidt-Kastner*, 153 USPQ 473 (POBA 1963). This is so because a compound and its properties are inseparable. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

Additionally, it must be borne in mind that a novel form of an old compound must possess a new utility or a utility of a different type. A mere improvement in properties does not render a novel form of an old compound patentable. *In re Weijland*, 587 OG 3,

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33 CCPA 837, 154 F.2d 133; 1946 CD 175, 69 USPQ 86; *Ex parte Hald*, Paper 15 in US 2,647,145.

With respect to claims 5 and 125, product-by-process claims, applicant is reminded that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) MPEP 2112.02.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
November 29, 2005